AF

TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No. ITL.0482US

In Re Application Of: **Eric C. Hannah and Michael Boyd**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/690,512	October 17, 2000	Jean D. Janvier	21906	3622	3230

Invention: **Ensuring that Advertisements Are Played**

COMMISSIONER FOR PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

November 2, 2006

The fee for filing this Appeal Brief is: **$500.00**

11/27/2006 CNEGA1 00000020 09690512
01 FC:1402 500.00 OP

☒ A check in the amount of the fee is enclosed.

☐ The Director has already been authorized to charge fees in this application to a Deposit Account.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. **20-1504**. I have enclosed a duplicate copy of this sheet.

☐ Payment by credit card. Form PTO-2038 is attached.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Signature

Dated: **November 21, 2006**

Timothy N. Trop, Reg. No. 28,994
TROP, PRUNER & HU, P.C.
1616 S. Voss Road, Suite 750
Houston, TX 77057
713/468-8880 [Phone]
713/468-8883 [Fax]

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on

November 21, 2006
(Date)

Signature of Person Mailing Correspondence

Nancy Meshkoff

Typed or Printed Name of Person Mailing Correspondence

cc:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:		§		
	Eric C. Hannah, et al.	§	Art Unit:	3622
		§		
Serial No.:	09/690,512	§	Examiner:	Jean D. Janvier
		§		
Filed:	October 17, 2000	§	Atty Docket:	ITL.0482US
		§		(P10030)
For:	Ensuring that Advertisements	§		
	Are Played	§	Assignee:	Intel Corporation
		§		

Mail Stop **Appeal Brief-Patents**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Date of Deposit: November 21, 2006
I hereby certify under 37 CFR 1.8(a) that this correspondence is being deposited with the United States Postal Service as **first class mail** with sufficient postage on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Nancy Meshkoff

TABLE OF CONTENTS

REAL PARTY IN INTEREST

The real party in interest is the assignee Intel Corporation.

RELATED APPEALS AND INTERFERENCES

Appeal No. 2005-0080, Decision mailed on March 18, 2005, in this case.

STATUS OF CLAIMS

Claims 1-7 (Rejected).

Claim 8 (Canceled).

Claim 9 (Rejected).

Claim 10 (Canceled).

Claims 11-17 (Rejected).

Claim 18 (Canceled).

Claim 19 (Rejected).

Claim 20 (Canceled).

Claims 21-30 (Rejected).

Claims 1-7, 9, 11-17, 19, and 21-30 are rejected and are the subject of this Appeal Brief.

STATUS OF AMENDMENTS

All amendments have been entered.

SUMMARY OF CLAIMED SUBJECT MATTER

In the following discussion, the independent claims are read on one of many possible embodiments without limiting the claims:

1. A method comprising:

monitoring a watermark included with an advertisement (Figure 2, 94, specification at page 7, lines 3-10);

accruing a credit after determining that the advertisement was played (Figure 2, 96, specification at page 7, line 23 to page 8, line 8); and

associating an indication that an advertisement was played with an identifier for a particular user (Figure 2, 98, specification at page 8, lines 9-16).

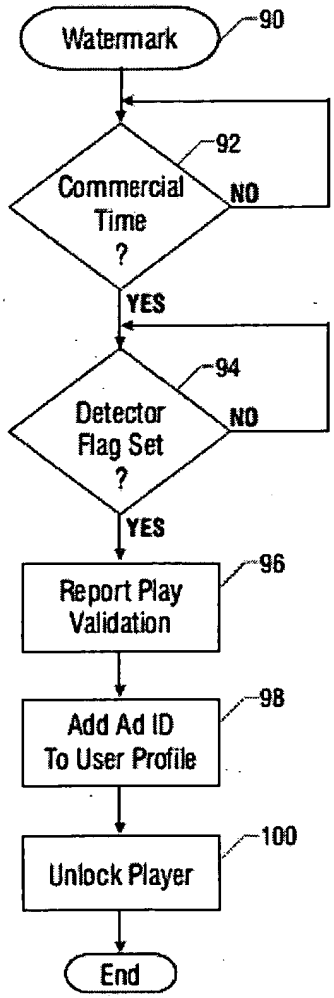

FIG. 2

5. The method of claim 1 wherein monitoring the watermark includes determining that the advertisement was played at a predetermined speed (specification at page 5, lines 15-20).

11. An article comprising a medium storing instructions that, if executed, enable a processor-based system to:

monitor a watermark included with an advertisement (Figure 2, 94, specification at page 7, lines 3-10);

accrue a credit after determining that the advertisement was played (Figure 2, 96, specification at page 7, line 23 to page 8, line 8); and

associate an indication that an advertisement was played with an identifier for a particular user (Figure 2, 98, specification at page 8, lines 9-16).

15. The article of claim 11 further storing instructions that, if executed, enable the processor-based system to determine that an advertisement was played at a predetermined speed (specification at page 5, lines 15-20).

21. A system comprising:

a processor-based device (Figure 1, 10);

a media player (Figure 1, 64) coupled to said processor-based device; and

a watermark detector (Figure 1, 60) coupled to said media player, said watermark detector to detect a watermark included with an advertisement and to control operation of said media player in response to detection of the watermark (specification at page 4, lines 8-20).

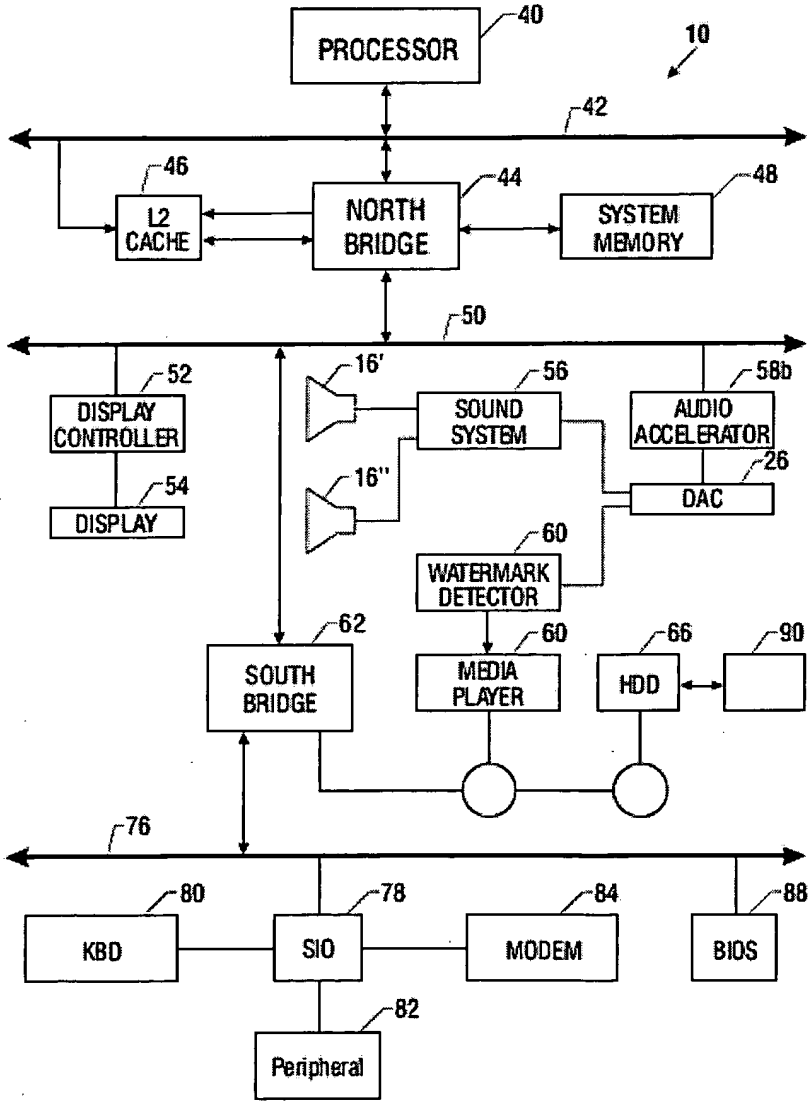

FIG. 1

25. The system of claim 21 wherein said watermark detector determines whether an advertisement was played at a predetermined speed (specification at page 5, lines 15-20).

29. A method comprising:

monitoring a watermark included with an advertisement (Figure 2, 94, specification at page 7, lines 3-10);

accruing a credit after determining that the advertisement was played (Figure 2, 96, specification at page 7, line 23 to page 8, line 8); and

controlling operation of a media player in response to monitoring the watermark (specification at page 4, lines 8-20).

30. An article comprising:

a medium storing instructions that, if executed, enable a processor-based system to:

monitor a watermark included with an advertisement Figure 2, 94, specification at page 7, lines 3-10);

accrue a credit after determining that the advertisement was played (Figure 2, 96, specification at page 7, line 23 to page 8, line 8); and

control operation of a media player in response to monitoring the watermark (specification at page 4, lines 8-20).

At this point, no issue has been raised that would suggest that the words in the claims have any meaning other than their ordinary meanings. Nothing in this section should be taken as an indication that any claim term has a meaning other than its ordinary meaning.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. **Whether claims 5, 15, and 25 are indefinite under § 112, second paragraph for failing to point out and distinctly claim the subject matter of the invention.**

B. **Whether claims 1-7, 9, 11-17, 19, and 21-30 are anticipated under 35 U.S.C. § 102(e) by Rodriguez (US 6,650,761).**

ARGUMENT

A. Are claims 5, 15, and 25 indefinite under § 112, second paragraph for failing to point out and distinctly claim the subject matter of the invention?

The rejections of claims 5, 15, and 25 under Section 112, paragraph 2 appears to arise from some principle of prematureness, again, nowhere specified in the patent law. To the extent that the rejection insists that the claims tell how to do something, there is no basis for such a rejection. The contention that there should be enough claim elements recited to enable one skilled in the art to understand the relationship between the watermark and the speed of playing is baseless.

Claim 5 is a method claim. It describes what to do, not the structural relationships. Similarly, claim 15 is a Beauregard claim and, again, assertion of relationships is not required.

Finally, claim 25 is a structural claim that defines what the watermark detector is. It is a device that determines whether an advertisement was played at a predetermined speed. There is nothing indefinite about it and one skilled in the art could readily understand what the concept is that is being claimed. Resort for details of the preferred embodiment should be made to the specification, not the claims.

Therefore the rejection should be reversed.

B. Are claims 1-7, 9, 11-17, 19, and 21-30 anticipated under 35 U.S.C. § 102(e) by Rodriguez (US 6,650,761)?

Claim 1 calls for *inter alia* associating an indication that an advertisement was played with an identifier for a particular user. There is no reference to any identifier for a particular user.

As best as it can be understood, the proposition is that the feature is implicit. There is no basis for an argument that something is implicit. The quality of being implicit is not recognized in the rules or the statute.

Apparently, the argument of implicitness is an attempt to avoid meeting the strict requirement for inherency. In order to be inherent, the feature must necessarily be present in the reference. Surely it cannot reasonably be contended that this is so. Much more likely, the reference simply ignores whoever it is that might be considered to be the user and simply provides the coupon regardless of whom or what was in front of the TV at the time the advertisement was played. The absence of any mention of any identifier suggests the more reasonable proposition that the cited reference never contemplated the association between an indication that the advertisement was played with an identifier for a particular user as claimed.

In the absence of any teaching whatsoever of the claimed limitation within the reference, the inapplicability of any argument of implicitness, and the impossibility of meeting an inherency requirement, the rejection is erroneous.

Claim 21 calls for a watermark detector coupled to a media player to detect a watermark included in the advertisement and to control operation of the media player in response to detection of a watermark.

Despite any supporting material within the specification of the cited reference, the Examiner surmises that for some reason the watermark detector in the cited reference, which simply determines whether the advertisement was played in its entirety, requires that, upon detection of the watermark, the advertisement be played in its entirety. But this makes no sense because if it were so, there would be no reason to determine whether play was done in its entirety in order to give the coupon. Necessarily, it must be played in its entirety, under the Examiner's reasoning, since the machine would prevent the player from being turned off or from otherwise being interrupted.

Instead, a reasonable reading of the reference is that it allows the user not to play the entire presentation, but rewards the user for doing so. Plainly, the reference teaches the carrot approach, not the stick approach. Assertions to the contrary are unsupported by anything within the reference.

Applicant respectfully requests that each of the final rejections be reversed and that the claims subject to this Appeal be allowed to issue.

Respectfully submitted,

Date: November 21, 2006

Timothy N. Trop, Reg. No. 28,994
TROP, PRUNER & HU, P.C.
1616 S. Voss Road, Suite 750
Houston, TX 77057
713/468-8880 [Phone]
713/468-8883 [Fax]

Attorneys for Intel Corporation

CLAIMS APPENDIX

The claims on appeal are:

1. A method comprising:

monitoring a watermark included with an advertisement;

accruing a credit after determining that the advertisement was played; and

associating an indication that an advertisement was played with an identifier for a particular user.

2. The method of claim 1 wherein accruing a credit includes accruing a credit to allow access to content.

3. The method of claim 1 wherein accruing a credit includes accruing a reward in return for playing the advertisement.

4. The method of claim 3 including accumulating rewards for successively playing advertisements.

5. The method of claim 1 wherein monitoring the watermark includes determining that the advertisement was played at a predetermined speed.

6. The method of claim 1 including monitoring the watermark included with a recorded advertisement.

7. The method of claim 1 wherein monitoring the watermark includes determining whether the advertisement was played at an intended time.

9. The method of claim 1 including controlling operation of a media player in response to monitoring the watermark.

11. An article comprising a medium storing instructions that, if executed, enable a processor-based system to:

monitor a watermark included with an advertisement;

accrue a credit after determining that the advertisement was played; and

associate an indication that an advertisement was played with an identifier for a particular user.

12. The article of claim 11 further storing instructions that, if executed, enable the processor-based system to allow access to content in return for playing the advertisement.

13. The article of claim 11 further storing instructions that, if executed, enable the processor-based system to accrue a reward in return for playing the advertisement.

14. The article of claim 13 further storing instructions that, if executed, enable the processor-based system to accumulate rewards for successively playing advertisements.

15. The article of claim 11 further storing instructions that, if executed, enable the processor-based system to determine that an advertisement was played at a predetermined speed.

16. The article of claim 11 further storing instructions that, if executed, enable the processor-based system to monitor the watermark included with a recorded advertisement.

17. The article of claim 11 further storing instructions that, if executed, enable the processor-based system to determine whether the advertisement was played at an intended time.

19. The article of claim 11 further storing instructions that, if executed, enable the processor-based system to control operation of a media player in response to monitoring the watermark.

21. A system comprising:

a processor-based device;

a media player coupled to said processor-based device; and

a watermark detector coupled to said media player, said watermark detector to detect a watermark included with an advertisement and to control operation of said media player in response to detection of the watermark.

22. The system of claim 21 further including a storage coupled to said device, said storage storing instructions that, if executed, enable the processor-based device to monitor the watermark included with the advertisement and accrue a credit after determining the advertisement was played.

23. The system of claim 22 wherein said storage stores instructions that, if executed, enable the device to allow access to content through said media player.

24. The system of claim 22 wherein said storage stores instructions that, if executed, enable the device to accrue a reward in return for playing the advertisement.

25. The system of claim 21 wherein said watermark detector determines whether an advertisement was played at a predetermined speed.

26. The system of claim 21 wherein said storage stores content for subsequent replay by said media player.

27. The method of claim 1 including determining that the advertisement was played, based on the watermark.

28. The article of claim 11 storing instructions that, if executed, enable the processor-based system to determine that the advertisement was played, based on the watermark.

29. A method comprising:

monitoring a watermark included with an advertisement;

accruing a credit after determining that the advertisement was played; and

controlling operation of a media player in response to monitoring the watermark.

30. An article comprising:

a medium storing instructions that, if executed, enable a processor-based system to:

monitor a watermark included with an advertisement;

accrue a credit after determining that the advertisement was played; and

control operation of a media player in response to monitoring the watermark.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

See Appeal No. 2005-0080 in this case, Decision mailed on March 18, 2005 on the following pages.

ITL.048245
P10030

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ERIC HANNAH and MICHAEL BOYD

MAILED
MAR 18 2005
U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

RECEIVED
MAR 22 2005
Trop, Pruner, & Hu, P.C.

Appeal No. 2005-0080
Application 09/690,512

ON BRIEF

Before JERRY SMITH, MACDONALD and NAPPI, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

Mail Date
Due Date 5-18-05
Act. Req. Status inquiry

DECISION ON APPEAL

TPHD☒ TPHA☐ ITLD☒

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-7, 9, 11-17, 19 and 21-30, which constitute all the claims remaining in the application. The disclosed invention pertains to a method and apparatus for monitoring a watermark included with an electronic advertisement. The watermark is used to determine that the advertisement has been played by a user. When it is determined

that the advertisement has been played by the user, the user is either given a credit or a media player is enabled to permit the user to view additional material.

Representative claim 1 is reproduced as follows:

1. A method comprising:
monitoring a watermark included with an advertisement;

accruing a credit after determining that the advertisement was played; and

associating an indication that an advertisement was played with an identifier for a particular user.

The examiner relies on the following references:

Filepp et al. (Filepp)	5,347,632	Sep. 13, 1994
Fite et al. (Fite)	5,557,721	Sep. 17, 1996
Graber et al. (Graber)	5,717,860	Feb. 10, 1998
Merriman et al. (Merriman)	5,948,061	Sep. 07, 1999

The following rejections are on appeal before us:

1. Claims 1-7, 9, 27, 29 and 30 stand rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.

2. Claims 1-7, 9, 11-17, 19, 27 and 28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Filepp.

3. Claims 21-26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Fite.

4. Claim 29 stands rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Graber.

5. Claim 30 stands rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Merriman.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the prior art rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the claimed invention is directed to statutory subject matter. We are also of the view that none of the prior art disclosures fully meet the invention as set forth in the claims on appeal. Accordingly, we reverse.

We consider first the rejection of claims 1-7, 9, 27, 29 and 30 under 35 U.S.C. § 101. It is the position of the examiner that these claims do not recite a useful, concrete and tangible

result under the decisions in In re Alappat, 31 USPQ2d 1545 (Fed. Cir. 1994) and State Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596 (Fed. Cir. 1998). Essentially, the examiner finds that the claimed invention involves nothing more than the manipulation of an abstract idea and is not tied to any technological art [answer, pages 3-5].

Appellants argue that there is no requirement in 35 U.S.C. § 101 that the claimed invention be performed with interaction of a physical structure. Appellants also argue that a digital watermark is defined as "a pattern of bits embedded into a file used to identify the source of illegal copies" and is, therefore, not an abstract idea as asserted by the examiner [brief, pages 6-7].

The examiner responds that appellants' proposed definition of "watermark" is too narrow. The examiner asserts that a watermark includes any identifying feature which characterizes an advertisement. The examiner argues that the claimed invention can be performed without mechanical intervention or structural limitation [answer, pages 5-9].

Appellants respond that the disclosed invention has substantial utility. They also argue that the examiner is not permitted to assert a definition of the term "watermark" that is

inconsistent with its well established meanings of the term in the art. Appellants argue that there is simply no basis for the examiner's position that a watermark as used in the claimed invention could be an abstract idea [reply brief, pages 1-4].

We will not sustain the examiner's rejection of the claims under 35 U.S.C. § 101. We agree with appellants that the examiner's interpretation of the term "watermark" as used in the claims on appeal is unreasonable. Even though appellants offer the definition of "digital watermark" and the word "digital" does not appear in the claims, we agree with appellants that the term "watermark" should be interpreted as a "digital watermark." The claims recite that an advertisement is "played." We are of the view that the "playing" of an advertisement requires that some form of physical implementation be used. Therefore, we agree with appellants that the claimed playing of the advertisement requires some physical interaction to occur. Since the playing of the advertisement is physical, we agree with appellants that the watermark recited in the claimed invention must be interpreted as a physical or digital watermark which is embedded within the files of the advertisement. When the claimed watermark is interpreted in this manner, it is clear that the

claimed invention is not simply limited to an abstract idea as argued by the examiner.

We now consider the various rejections under 35 U.S.C. § 102. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Appellants argue that neither Filepp, Fite, Graber nor Merriman makes any mention of monitoring a watermark included with an advertisement, that is, monitoring a pattern of bits embedded into a file. Appellants also argue that none of these references teaches or suggests a watermark detector to control operation of a media player in response to detection of a watermark [brief, pages 9-10].

The examiner responds that the user characteristics of Filepp meet the claimed watermark. The examiner also responds that Fite teaches the watermark detection operation by keeping

statistics of advertisement display and by relaying such statistics to a host system. The examiner also asserts that the URL symbols of Graber also meet the claimed watermark. Finally, the examiner responds that the tracking of advertisements in Merriman anticipates the claimed watermark monitoring [answer, pages 10-15].

Appellants respond that none of the applied references show a watermark as reasonably defined or have anything whatsoever to do with such watermarks. Appellants argue that all rejections should be reversed because the examiner's interpretation of the term "watermark" is contrary to the plain meaning of the term [reply brief, page 4].

We will not sustain any of the examiner's rejections of the claims under 35 U.S.C. § 102. As noted above, the only reasonable interpretation of the claimed "watermark" is that it is a digital watermark as argued by appellants. As noted above, a digital watermark is defined as a pattern of bits embedded into a file used to identify the source of illegal copies. None of the references cited by the examiner discloses such a watermark or the monitoring of such a watermark as claimed.

In summary, we have not sustained any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-7, 9, 11-17, 19 and 21-30 is reversed.

REVERSED

JERRY SMITH)
Administrative Patent Judge)
)
)
)
ALLEN R. MACDONALD) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
)
ROBERT E. NAPPI)
Administrative Patent Judge)

JS/dym

Timothy N Trop
Trop Pruner & HU PC
8554 Katy Freeway Ste 100
Houston, TX 77024